

REMARKS

Claims 1-24 are currently pending in this application, of which claims 1 and 14 are independent. In the Final Office Action dated July 9, 2008, the Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,000,178 ("*Messinger*") in view of U.S. Patent No. 7,080,327 ("*Bartz*"). Applicants respectfully traverse the Examiner's rejection because it fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Under 35 U.S.C. § 103(a), several basic factual inquiries must be made in order to evaluate whether a patent claim is obvious or non-obvious. According to The Manual of Patent Examining Procedure ("the M.P.E.P."), obviousness is a question of law based on these factual inquiries. THE MANUAL OF PATENT EXAMINING PROCEDURE § 2141(II) (8th ed. rev. 6 Sept. 2007) (citing KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and relying on the framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467 (1966)). In particular, the Graham factual inquiries create a four-part framework for evaluating whether a patent claim is obvious or non-obvious. Graham, 383 U.S. at 17. Those factual inquiries are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims at issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Id. The M.P.E.P. advises that the question of obviousness must be resolved on the basis of these factual determinations. M.P.E.P. § 2141(II).

The M.P.E.P. also provides guidelines for making these factual determinations. For example, the M.P.E.P. cautions that in order to avoid impermissible hindsight reasoning, these factual determinations must be made “at the time the invention was made.” § 2141.01(III). Moreover, the M.P.E.P. states that when “determining the differences between the prior art and the claims, the question [of obviousness] is not whether the differences themselves would have been obvious, but [rather, it is] whether the claimed invention as a whole would have been obvious.” § 2141.02(I). Indeed, when considering the prior art, [a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” § 2143.03(VI) (second emphasis added).

Once the Graham factual inquiries have been resolved, it must be determined whether a claim is *prima facie* obvious. § 2141(III). Following the guidance of the above-outlined framework, the M.P.E.P. points out that in order to establish a *prima facie* case of obviousness, “the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” § 2142. Further, “the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person,” and further, that “[k]nowledge of applicant’s disclosure must be put aside in reaching this determination” because “impermissible hindsight must be

avoided and a legal conclusion must be reached on the basis of the facts gleaned from the prior art”; not on the basis of applicant’s disclosure. Id.

Based on this guidance, the M.P.E.P. advises “[i]f a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” § 2143.01(VI). In other words, if the prior art teaches away from a proposed modification, then the prior art does not render a claim *prima facie* obvious. Moreover, the M.P.E.P. advises that all of the subject matter recited in a claim must be considered when evaluating whether a claim is *prima facie* obvious. § 2143.03. Thus, the claimed invention as a whole must be evaluated, and if the prior art as a whole fails to render all of the recited subject matter obvious, the prior art does not render a claim *prima facie* obvious. See id.

Applicants respectfully submit that the proposed combination of *Messinger* and *Bartz* fails to support a *prima facie* case of obviousness that satisfies either the Graham factual inquiries or the standard for *prima facie* obviousness set forth in the M.P.E.P. at least because 1) *Bartz* teaches away from being combined with *Messinger* to arrive at Applicants’ invention of independent claims 1 and 14, and 2) neither *Messinger* nor *Bartz* discloses all of the subject matter recited in each of independent claims 1 and 14.

More specifically, independent claims 1 and 14 each recite, among other things, “a first pane displaying an active roadmap of two or more of the ordered steps of a

particular task and for indicating a selected one of the two or more ordered steps, wherein at least one step not previously performed and not immediately following the selected step in the ordered steps of the particular task is selectable by a user." This process allows the user to proceed or skip directly to a later step in the sequence of ordered steps of a particular task, where the later step is not yet performed and not immediately following the currently selected step. (See Applicants' disclosure, at page 23, paragraph 91.) The ability to skip to an unperformed step of the particular task is advantageous because "[a]s users become more proficient with the system, the present disclosure contemplates that users may reduce the level of guidance provided by the interface. Thus, user interfaces designed according to the teachings of the disclosure provide simple, low-level guidance to new users, [while] allowing the user to tailor the system as his experience increases." (See Applicants' disclosure, at page 10, paragraph 49.)

In making the rejection of independent claims 1 and 14, the Examiner conceded that *Messinger* fails to show or suggest the above feature. However, the Examiner contended that *Bartz* may be used to modify *Messinger* and the combination would show this feature because *Bartz* describes a microcontroller design tool that allows a user to "move from the Debugger subsystem back to the Device Editor system without having to pass through the Application Editor system." Final Office Action, page 3. Contrary to the Examiner's contention, Applicants submit that the cited description in *Bartz* cannot properly be used in combination with *Messinger* to arrive at the Applicants'

invention of claims 1 and 14 because *Bartz* teaches away from the Applicants' invention. Specifically, *Bartz* describes moving "from the Debugger subsystem back to the Device Editor system." This backward only movement makes logical sense in *Bartz* because a user cannot debug if there is no code to run. Even if *Bartz* then allows the user, after having gone back to the Device Editor system from the Debugger subsystem, to return to the Debugger subsystem, it would have been because the user had "previously performed" a task at the Debugger subsystem (i.e., to go back to the Device Editor system). This is contrary to the recitation of Applicants' independent claims 1 and 14, which specifically requires that "at least one step not previously performed and not immediately following the selected step in the ordered steps of the particular task is selectable by a user" so as to allow a user to skip to an unperformed step of the particular task.

As outlined above, a *prima facie* case of obviousness cannot be established where the reference teaches away from the Applicants' invention. See § 2143.01(VI). Therefore, at least because *Bartz* teaches away from the Applicants' invention of claims 1 and 14, the Final Office Action has failed to establish a *prima facie* case of obviousness.

Furthermore, Applicants submit that even if *Messenger* and *Bartz* were combined in the hypothetical manner proposed, the combination fails to disclose or suggest all the claimed subject matter. More specifically, in order to establish a *prima facie* case of obviousness, the prior art, when combined, must render all of the subject matter recited

in a claim obvious. See M.P.E.P. § 2143.03. As conceded by the Examiner, *Messinger* fails to show or suggest “a first pane displaying an active roadmap of two or more of the ordered steps of a particular task and for indicating a selected one of the two or more ordered steps, wherein at least one step not previously performed and not immediately following the selected step in the ordered steps of the particular task is selectable by a user,” as recited in independent claims 1 and 14. *Bartz*, as discussed above, merely describes “move from the Debugger subsystem back to the Device Editor system” and does not contemplate skipping forward to “at least one step not previously performed and not immediately following the selected step in the ordered steps of the particular task.” Therefore, even when *Messenger* and *Bartz* are combined as proposed, the combination would only show going back to a step that was previously performed and would still fail to show or suggest “a first pane displaying an active roadmap of two or more of the ordered steps of a particular task and for indicating a selected one of the two or more ordered steps, wherein at least one step not previously performed and not immediately following the selected step in the ordered steps of the particular task is selectable by a user,” as recited in independent claims 1 and 14.

For at least the above reasons, Applicants respectfully submit that *Messenger* and *Bartz*, regardless of whether they are viewed individually or as a whole, fail to disclose or suggest all of the subject matter recited in independent claims 1 and 14. Thus, independent claims 1 and 14 are not *prima facie* obvious based on *Messenger* and *Bartz*. Applicants also submit that dependent claims 2-13 and 15-24 depend from

independent claims 1 and 14, respectively, and are, therefore, also not rendered obvious by the combination of references under 35 U.S.C. § 103(a).

Accordingly, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.


Applicants respectfully request that this Reply To Final Office Action be entered by the Examiner, placing claims 1-24 in condition for allowance. Applicants submit that the proposed response does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Reply should allow for immediate action by the Examiner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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